REMARKS

Claims 1-18 are pending in the present application, and claims 1-18 were rejected in the Office Action dated June 14, 2005. In this Amendment, claim 1 is amended and no claims are added or canceled. No new matter has been added.

I. 35 U.S.C. § 101 Non-Statutory Subject Matter Rejection of Claims

The Examiner contends that claim 1 reads on a mental process or the manipulation of an abstract idea, and not a statutory device. Applicants respectfully submit that the Examiner's contention is erroneous. Claim 1 recites "obtaining said spreadsheet file in a first format on a first device." A human cannot mentally or abstractly obtain a spreadsheet file on a device. The spreadsheet file must be physically embodied on the device, or else it has not been obtained. Claim 1 further recites "transferring said spreadsheet file to a second device." Again a human cannot mentally or abstractly transfer a spreadsheet file to a second device. The spreadsheet file must be physically moved and then physically embodied on the second device in order for the spreadsheet filed to have been transferred.

Although Applicants contend claim 1 clearly reads on a statutory process rather than a mental process or manipulation of an abstract idea, in order to advance prosecution Applicants amend claim 1 to recite "a method in a data processing system." This amendment clarifies that the claimed method does not read on a mental process or an abstract idea. Accordingly, the rejection is erroneous with respect to amended claim 1 and its depending claims 2-8 and should be withdrawn.

II. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 1-4 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horie et al. (US Patent 6,487,597, hereinafter "*Horie*") in view of *Schlafly* (US Patent 5,471,612). Applicants respectfully traverse this rejection.

Applicants initially note that claim 1 recites "evaluating one or more formulas while converting said spreadsheet file." This limitation was added to claim 1 in the Amendment of April 25, 2005, the entry of which the Examiner acknowledges in the present Official Action. The Examiner does not mention this limitation with respect to the cited art, and therefore fails to establish that *Horie*, *Schlafly*, or any combination thereof teaches or suggests this limitation. For at least this reason, *prima facie* obviousness has not been established. Moreover, Applicants submit that the combination of *Horie* and *Schlafly* fails to teach or suggest evaluating formulas **while** converting the spreadsheet file.

Furthermore, Applicants respectfully submit the combination of *Horie* and *Schlafly* fails to teach or suggest every limitation of claim 1. Claim 1 recites, for example, "converting said spreadsheet file to a second format wherein said converting further comprises evaluating one or more formulas" (Emphasis added). The Examiner concedes that *Horie* does not teach the emphasized limitation, but asserts that *Horie* as modified by *Schlafly* does teach every limitation of the claim. However, the Examiner fails to establish a motivation to combine the references as proposed. To establish this motivation, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). However, *Horie* never discloses a formula in need of evaluation. Indeed, the word "formula" does not even appear in the text of the

patent. Thus, one of ordinary skill in the art would not be motivated to modify *Horie* with *Schlafly* as proposed by the Examiner.

Moreover, the Examiner contends that the motivation to combine is found in the increased speed of transmission of the spreadsheet from the personal computer to the PDA. This contention is illogical, however, as the evaluation of formulas during conversion and transmission would require more computation and add more data to the file being transmitted, thus slowing the speed of transmission. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (Emphasis original), *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Horie fails to provide the requisite desirability for the proposed modification.

Claim 10 is not unpatentable over *Horie* in view of *Schlafly* for at least the same reasons that claim 1 is not unpatentable over *Horie* in view of *Schlafly*. Claims 2-4 and 11-13 depend upon claims 1 and 10 respectively and are also therefore not unpatentable.

Claims 5-9 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Horie* in view of *Schlafly*, and further in view of *Pajokowski* et al. (US Patent 6,718,425). Applicants respectfully traverse the rejection to the claims. The rejection of claims 5-9 and 14-18 relies on the propriety of the rejection of claims 1 and 10, respectively. As previously explained, those rejections are erroneous.

III. Conclusion

In view of the above remarks, Applicants submit that all claims are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: September 14, 2005

By: _____
A. Wesley Ferrebee
Registration No. 51,312

Customer No.: 26263
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
Phone: (202) 408-9214
Fax: (312) 876-7457